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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,671	08/04/2005	Mauro Napoletano	265084US0PCT	8632

22850	7590	10/15/2007
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.		
1940 DUKE STREET		
ALEXANDRIA, VA 22314		

EXAMINER	
PESELEV, ELLI	

ART UNIT	PAPER NUMBER
1623	

NOTIFICATION DATE	DELIVERY MODE
10/15/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

<b>Office Action Summary</b>	Application No. 10/522,671	Applicant(s) NAPOLETANO ET AL.	
	Examiner Elli Peselev	Art Unit 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 30-32 is/are rejected.
- 7) ☒ Claim(s) 21-29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-16 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonnet et al (U.S. Patent No. 5,969,161).

Bonnet et al disclose the claimed antibacterial erythromycin derivative wherein R is hydrogen or methyl, R1 is a dimethylamino group, R2 is hydrogen and R3 and R4 for an oxime group (columns 3 and 4).

Applicant's arguments filed September 4, 2007 have been fully considered but they are not persuasive.

Applicant contends that Bonnet et al do not disclose or suggest the claimed compound because of the proviso that R1 is not a dimethylamino group when R5 is a hydrogen, a linear or branched C<sub>10</sub>C<sub>5</sub> alkyl or unsubstituted benzyl. This argument has not been found persuasive because Bonnet et al disclose substituted benzyl, such as phenyl (column 1, lines 32-35 and column 2, lines 10-11). The composition claim encompasses nothing more than an old compound in water.

Claims 1-16 and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Lundy et al (U.S. Patent No. 6,043,226).

Lundy et al disclose the claimed compounds wherein R is a hydrogen atom or a methyl group, R1 is dimethylamino, R2 is hydrogen, R3 is hydroxyl and R4 is hydrogen. (column 10).

Applicant's arguments filed September 4, 2007 have been fully considered but they are not persuasive.

Applicant contends that the proviso "R1 is not a dimethylamino group when R3 is hydroxy, and both R2 and R4 are hydrogens" excludes compounds disclosed by Lundy et al. This argument has not been found persuasive because Lundy et al also disclose compounds wherein R3 is hydrogen and R4 is hydroxy.

Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Ku et al (U.S. Patent No. 5,892,008).

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Ku et al disclose the claimed compound wherein R is methyl, R1 is dimethylamino group, R2 is hydrogen and one of R3 and R4 is hydrogen and the other is hydroxy (column 6, compound (6)).

Applicant's arguments filed September 4, 2007 have been fully considered but they are not persuasive.

Applicant contends that Ku fails to disclose the claimed compound because claim 20 recites that "R1 is not an N,N-dimethyl amino group". This argument has not been found persuasive.

Claim 20 recites that R1 is not an N,N-dimethyl amino group when R is a hydrogen atom. However, Ku et al disclose the claimed compound wherein R is methyl.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonnet et al (U.S. 5,696,161) or Lundy et al (U.S. Patent No. 6,043,226) in combination with Agouridas et al (U.S. Patent No. 6,096,714).

Each of Bonnet et al and Lundy et al discloses the claimed compounds but does not disclose a process for preparing said compounds by removing cladinose moiety by acid hydrolysis. However, since Agouridas et al disclose a process for removing cladinose moiety by acid hydrolysis from an erythromycin derivative (column 4, lines 47-50), a person having ordinary skill in the art at the time the claimed invention was made would have been motivated to prepare compounds disclosed by Bonnet et al or Lundy et al because the results obtained from such a process would have been expected.

Applicant's arguments filed September 4, 2007 have been fully considered but they are not persuasive.

Applicant's arguments are not persuasive because the claimed compounds are still read on the compounds disclosed by Bonnet et al and Lundy et al.

Claims 21-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

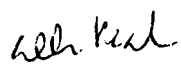
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elli Peselev whose telephone number is (571) 272-0659. The examiner can normally be reached on 8.00-4.30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia Jiang can be reached on (571) 272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Elli Peselev

  
ELLI PESELEV  
PRIMARY EXAMINER  
GROUP 1200